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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,614	09/29/2005	Bruce Milner	ELI2-22775/APCT	1766
324 7590 07/14/2009 JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591				
EXAMINER ANGEBRANDT, MARTIN J				
ART UNIT 1795		PAPER NUMBER		
NOTIFICATION DATE 07/14/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/533,614

**Applicant(s)**

MILNER ET AL.

**Examiner**

Martin J. Angebrandt

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1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-8, 12, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 12, 13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 4-8, 12, 13 and 15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

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1. The response of the applicant has been read and given careful consideration. Responses to the arguments of the applicant are presented after the first rejection to which they are directed.
2. The restriction requirement of the previous office action is incorporated by reference here and maintained. The active claims are claims 1,4-7,12,13, and 15, claims 8 and 16-17 are withdrawn.
3. Applicant's election with traverse of group I in the reply filed on 11/28/08 is acknowledged. The traversal is on the ground(s) that group II requires the composition of group I. This is not found persuasive because the composition has other uses than as a coating for optical recording media as in the process of group II.

The requirement is still deemed proper and is therefore made FINAL.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,4-7,12,13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al. JP 2002-109793, in view of Fabian et al. '233.

Koike et al. JP 2002-109793 (machine translation attached) teaches in examples 5 a phthalocyanine dye and a benzoylferrocene dye dissolved in 1,2-dimethylcyclohexane:o-xylene (4%, 25:1)[0045]. The aliphatic hydrocarbon solvents include various alkanes, methylcyclohexane, ethylcyclohexane, propylcyclohexane,

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cycloheptane and aromatic hydrocarbons such as toluene, xylenes, ethylbenzene, and mesitylene (trimethylbenzene). [0023].

Fabian et al. '233 teaches the use of toluene, xylenes, i-propylbenzene and butylbenzene as solvents for phthalocyanines and into which the phthalocyanine partitions. (2/34-43,3/6-42).

It would have been obvious to one skilled in the art to modify the solvent mixture of example 5 by using other aromatic solvents which are known solvents for phthalocyanines, such as butylbenzene, in place of the xylene based upon the teachings of Fabian et al. '233.

The benefit observed in table 2, seems to be related to the use as a coating composition for a polycarbonate substrate and does not logically extend to other substrates with different compositions such as glass. The showing is therefore not commensurate in scope with the coverage sought.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The primary reference is Koike et al. and the Fabian reference is used to establish the equivalence of o-xylene and butylbenzene as a solvent to phthalocyanines similar to that used in the example of Koike et al., who uses a mixture similar that claimed. One skilled in the art would recognize the chemical and structural similarity of o-xylene (o-dimethylbenzene) and butylbenzene as these are both clearly alkyl substituted benzenes and would make the shorter step of using these rather than going to a whole different

class of solvents (halogenated hydrocarbons). The argued groove filling benefit is only relevant to the composition in contact with a grooved substrate and the applicant has not provided data in table 1 for a composition similar to that of Koike et al. which might support the argued position. Only dissolution data is provided for a 1,2-dimethylcyclohexane:o-xylene solvent composition.

The applicant could provide data similar to that found in table 1 (ie performance data) for the methylcyclohexane:o-xylene solvent composition used in table 2 and claim the composition applied to the grooved surface of a polymeric optical recording medium substrate. This data would be a broader showing than the dissolution data in table 2 and could entitle the applicant to broader coverage. If the article/composition claims were limited to this embodiment and the appropriate evidence made of record, then rejoinder might be proper. The rejection stands.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebranndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Martin J Angebranndt/  
Primary Examiner, Art Unit 1795

Martin J Angebranndt  
Primary Examiner  
Art Unit 1795

7/9/09